

REMARKS

Applicants thank Examiner Wong for here courteous and congenial telephone interview with Applicants' representative on July 20.

Applicants also thank Examiner Wong for withdrawing the objection of the specification; the rejection of claims 1-4 under 35 U.S.C. §112, second paragraph and claims 1-4 under 35 U.S.C. §103(a) over JP 7-138782 and U.S. 6,500,327 to Saitoh et al.

Claims 1 and 4-7 are pending in the present application.

Claims 2 and 3 are canceled. Claim 2 is canceled with this Amendment.

Claim 1 is amended to recite the subject matter of canceled claim 2.

Claim 7 is new and further limits the amount of bismuth in the tin electrolyte. Support in the specification for new claim 7 is at page 4, line 22.

Claims 1 and 5-6 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over JP 11-181589 ('589). Applicants respectfully traverse this rejection.

Claim 1 is amended to recite the subject matter of canceled claim 2. Accordingly, the '589 application does not teach or suggest the subject matter of present claim 1.

Claims 5-6 depend directly or indirectly from amended claim 1. Accordingly, they are patentable over '589 for the same reasons as claim 1.

New claim 7 is also patentable over '589 for at least the reason that it also depends from amended claim 1.

Applicants respectfully request withdrawal of the rejection of claims 1 and 5-6 under 35 U.S.C. §103(a) as allegedly unpatentable over JP 11-181589 ('589).

Claim 2 is rejected under 35 U.S.C. §103(a) as allegedly unpatentable over JP 11-181589 ('589) as applied to claims 1 and 5-6 and further in view of JP 7-138782 ('782). Applicants respectfully traverse this rejection.

Claim 2 is canceled. Accordingly, the rejection with respect to claim 2 is moot.

Present claims 1 and 5-6 are patentable over '589 for the reasons discussed above.

The application '782 does not make up for the deficiencies of '589. The '782 application does not teach or suggest the specific range of bismuth included in the claimed composition or the advantages of the amount of bismuth. It is well settled that the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge

of the claimed invention, would select the elements from the cited documents for combinations in the manner claimed. See *In re Rouffet*, 47 U.S.P.Q.2d at 1458 (Fed. Cir.1998). The presently claimed electrolyte tin-plating solution is not only directed to improved soldering, but it is directed to low concentrations of bismuth to prevent brittle tin films (specification, page 4, lines 18-21). This is achieved with low concentrations of bismuth in the electrolyte. Such concentrations range from 0.01 to 0.5 g/L or from 0.02 to 0.2 g/L. The '589 application is totally silent on the amount of bismuth included in the tin-bismuth electrolyte, and the '782 application discloses a range which far exceeds the low levels recited in the present claims. Neither of the applied documents provides any reason or motivation to limit the scope of bismuth to the recited ranges of the present claims to address the problem of preventing brittle tin films. It is only by happenstance that a person of skill in the art would have limited the bismuth content to achieve a brittle free tin layer. Accordingly, claims 1 and 5-7 are patentable over the applied documents.

Claim 4 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP 11-181589 ('589). Applicants respectfully traverse this rejection.

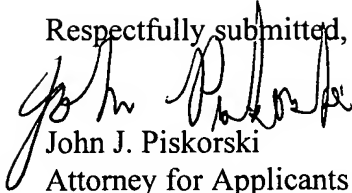
Claim 4 includes the tin electrolyte of present claim 1. Accordingly, claim 4 is patentable over '589 for the same reasons as claim 1.

Applicants respectfully request withdrawal of the rejection of claim 4 under 35 U.S.C. §103(a) as allegedly unpatentable over JP 11-181589 ('589).

Favorable consideration and allowance of claims 1 and 4-7 are earnestly solicited.

Should the Examiner have any questions concerning this response or this application, or should she believe this application is for any reason not yet in condition for allowance, she is respectfully requested to telephone the undersigned at the number set forth below in order to expedite this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John J. Piskorski", is written over the typed name.

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